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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/196,673 11/20/98 MCCAFFERTY J 28111/32106B

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HM12/1221

EXAMINER

PONNALURI, P

ART UNIT

PAPER NUMBER

1618
DATE MAILED:

12/21/99

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

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1. The preliminary amendment filed on 11/20/98 has been fully considered and entered into the application.
2. New claims 44-144 have been added and claims 1-43 have been canceled by the amendment filed on 11/20/98.

Election/Restriction

3. Restriction to one of the following inventions is required under 35 U.S.C. 121:
 - Group 1. Claims 44-65, drawn to a method of obtaining a member of a specific binding pair and a method of producing nucleic acid encoding a specific binding pair, classified in class 435, subclass 69.1.
 - Group 2. Claims 66-69, drawn to a recombinant host cells harboring a library of nucleic acids, classified in class 435, subclass 252.3.
 - Group 3. Claims 70-73, drawn to a filamentous bacteriophage particle, classified in class 435, subclass 235.1.
 - Group 4. Claims 74-77, drawn to a library of filamentous phage particles, classified in class 435, subclass 235.1.
 - Group 5. Claims 78-85, drawn to a method of obtaining a member of a specific binding pair by contacting a library of filamentous phage, classified in class 435, subclass 69.1.

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Group 6. Claims 86-109, drawn to a method of producing a specific binding pair member (using the nucleic acid from group V), classified in class 435, subclass 69.1.

Groups 7-14, 21-31 and 40-43. Claims 110-115 and 122-132, drawn to a specific binding pair member, classified in class 530, subclass 386.

Groups 15-20, and groups 32-39. Claims 116-121 and 133-140, drawn to nucleic acid, classified in class 536, subclass 23.1.

4. The inventions are distinct, each from the other because of the following reasons:

Inventions of groups 1, 5-7 and 7-14, 21-31 and 40-43 are related as process of making and product made. The inventions are distinct if either or both of the following can be shown: (1) that the process as claimed can be used to make other and materially different product or (2) that the product as claimed can be made by another and materially different process (MPEP § 806.05(f)).

In the instant case the inventions of groups 1, 5, 6 are drawn to methods of obtaining specific binding pair member and groups 7-14, 21-31 and 40-43. are drawn to the product (specific binding pair), the specific binding pair member of groups 7-14, 21-31 and 40-43. can be obtained by different process like immunogenically and do not require the recombinant methods of groups 1, 5, and 6 .

5. Inventions of groups 1, 5 and 6 and groups 15-20, and groups 32-39 are related as process of making and product made. The inventions are distinct if either or both of the following can be shown: (1) that the process as claimed can be used to make other and materially different

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product or (2) that the product as claimed can be made by another and materially different process (MPEP § 806.05(f)). In the instant case the inventions of groups 1, 5 and 6 are drawn to methods of obtaining specific binding pair member and groups 15-20, and groups 32-39 are drawn to the product (nucleic acid obtained from the specific binding pair), the product of groups 15-20, and groups 32-39 can be obtained by different process and do not require the recombinant methods of groups 1, 5 and 6 .

6. Inventions of groups 1, 5, 6 and 2 are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In the instant case the inventions of groups 1, 5, and 6 are drawn to methods of obtaining specific binding pair member and group 2 inventions are drawn to a product (recombinant cells), and the recombinant cells of group 2 can be used in various other assays.

7. Inventions of group 3 and group 4 are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case the different inventions of group 3 are drawn to a filamentous bacteriophage and group 4 inventions are drawn to a library of filamentous bacteriophage, which are not required for group 3 inventions and the inventions of group 3 and group 4 can not be used together.

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8. Inventions of group 1, 5 and 6 are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case the different inventions of group 1, group 5 and group 6 are drawn to methods of obtaining specific binding pair using different method steps. Thus restriction among the groups is proper.

9. Inventions of groups 15-20, and groups 32-39 are drawn to nucleic acids obtained by different method steps. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case the different inventions of groups 15-20, and groups 32-39 are not related and do not require one for the other.

10. Inventions of groups 7-14, 21-31 and 40-43 are drawn to specific binding pairs obtained by different method steps. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case the different inventions of groups 7-14, 21-31 and 40-43 are not related and do not require one for the other.

11. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification and because of their recognized divergent subject matter, restriction for examination purposes as indicated is proper.

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12. Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).
13. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a petition under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(I).
14. Applicant is required to reply to this restriction requirement within 30 days of mailing this action. See MPEP 809.2(a).

Any inquiry concerning this communication should be directed to P. Ponnaluri whose telephone number is (703) 305-3884. The examiner can normally be reached on Monday through Friday from 8:00 am to 4:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Donald Adams, can be reached at (703)308-0570. The fax number for this group is (703)305-3014.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the group receptionist whose telephone number is (703)308-0916.

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P. Ponnaluri
Patent Examiner
Technology Center 1600
Art Unit 1618

18 December 1999



RESTRICTION ELECTION FACSIMILE TRANSMISSION

DATE:

FROM/ATTORNEY:

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